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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,598	01/20/2004	Peter M. Bonutti	781-A04-006-3	1100

33771 7590 01/11/2006

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SUITE 115
MIAMI, FL 33180

EXAMINER

BROWN, MICHAEL A

ART UNIT	PAPER NUMBER
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3764

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/760,598	Applicant(s) BONUTTI ET AL.	
	Examiner Michael Brown	Art Unit 3764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2005.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-23 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 6-9, 12-18, 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bastyr in view of Taylor.

Bastyr discloses in figures 1-4B shoulder orthosis comprising a lower arm section 64, a drive member (54, 56), a lower cuff 36, hand cuff 42, the drive mechanism is rotated manually and rotates the lower arm section from different positions, an upper arm section (the flat rectangular shaped portion connected into 54, in fig. 3), that is adjustable, a base section 48, a second drive means 72. However, for the sake of argument, Taylor teaches in figures 1-4 s shoulder orthosis comprising a first drive mechanism 20 and a second drive mechanism 30. It would have ordinary skill in the art at the time that the invention was made that the first and second drive mechanism as taught by Taylor could be substituted for the drive mechanisms disclosed by Bastyr because the four drive mechanism are interchangeable.

Claims 4-5, 10-11 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims above, and further in view of Schween.

Schween teaches in figure 3 a shoulder orthosis comprising an arm section having an outer 141 and an inner 161 channel members. It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the inner and outer channel members as taught by Schween could be incorporated into the lower arm section disclosed by Bastyr in order to be able to adjust the length of the lower arm section.

Response to Arguments

Applicant's arguments filed October 28, 2005 have been fully considered but they are not persuasive. Applicant argues that Bastyr is non-analogous prior art. However, Applicant claims a shoulder orthosis device. Bastyr discloses a shoulder brace (brace and orthosis are interchangeable terms used in the surgical art). Applicant argues that Bastyr is directed towards an orthopedic shoulder brace for stabilizing and immobilizing a shoulder of a patient. However, no patentable weight can be given to whether Bastyr is used to hold the arm in a specific position. The reason for this decision is no part of the body can be claimed and if locating the body part was patentable all one would have do is simply continue to locate the body part at different angles or locations while using the same structural limitations. The claims in the present invention are article/product claims. Thus, no patentable weight was given to where the different structural elements of the device are used to locate specific parts of the body. Applicant argues that there is no motivation to substitute the drive mechanisms as taught by Taylor for the drive mechanisms disclosed by Bastyr. However, substituting one drive mechanism for another drive mechanism is simply a matter of interchanging the device. Both are used

to move the arm that is located inside of an orthosis. Applicant argues that Bastyr discloses an orthosis that rotates the lower arm about an axis located a distance from the humerus bone, while the present invention claims an orthosis that rotates the lower arm about the central longitudinal axis of the humerus bone. However, as set forth above, no patentable weight can be given to what body part the device is rotated about. Applicant argues that the combination of Bastyr and Taylor fail to disclosed a drive mechanism that is operably connected to the lower arm section to rotate the lower arm portion about the central longitudinal axis of the humerus bone, while maintaining the lower arm portion substantially orthogonal to the upper arm portion. However, Bastyr discloses a drive member as to what the drive member is operable to do wasn't given any patentable weight.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

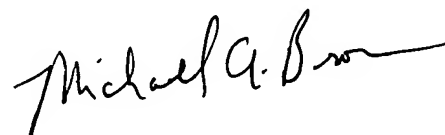
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Brown whose telephone number is 571-272-4972. The examiner can normally be reached on 5:30 am-4:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gergory Huson can be reached on 571-272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Brown
January 6, 2006

A handwritten signature in black ink, appearing to read "Michael A. Brown", with a stylized flourish at the end.

MICHAEL A. BROWN
PRIMARY EXAMINER